

REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated July 25, 2005. Reconsideration and allowance is requested.

Claims 1-3, 5, 6, 8-20, and 36-38 remain in this application. Claims 4, 7, and 21-35 were previously canceled. Claims 36-38 are new claims added by this amendment.

Claim Rejection Under 35 USC 112

In the Office Action claim 15 was rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The Examiner believes that page 7 lines 5-7 of the instant specification contradicts the claimed invention because the portion of overhead for zone i is region Xi and if the two zones are not the same, then their regions are not the same. In page 7 lines 8-11 the specification states: "If multiple monitoring zones are set up and there is overlap in some of the optical transmission devices 100 in the monitoring zones, different regions Xi in the transmission signal 52 will be specified." Therefore it is possible that the same regions Xi are specified for multiple monitoring zones that are not overlapping. Moreover, the specification explains in page 7 lines 5-7, that references made to "region Xi" is just a convention adopted for discussion purposes. Therefore, it does not always follow that region X1 and region X2 are different portions of an overhead. Therefore, in light of these remarks counsel for assignee believes that claim 15 complies with the enablement requirement of 35 USC 112, first paragraph.

Also, claims 1-3 and 5-6 were rejected under 35 USC 112, second paragraph, as being indefinite because it is unclear whether in claim 1, the limitation "identifying a second optical transmission device" in line 10 and the limitation "a second optical transmission device" in lines 19-20, refer to the same optical transmission device. Claim 1 has been amended to show that they are the same. Additionally, claims 5 and 6 were rejected because they depended from claim 4 which was canceled. Claims 4 and 5 have been amended to depend from claim 1.

In light of these remarks and amendments, counsel for assignee believes the rejection of claims 1-3, 5-6, and 15 under 35 USC 112 have been overcome and respectfully request that the rejection be withdrawn.

Claim Rejection Under 35 USC 103

In the Office Action, claims 1-3, 5-6, 8-18 were rejected under 35 USC 103(a), as being unpatentable over Fee et al. (U.S. Patent 5,956,165) in view of Joline et al. (U.S. Patent 6,005,696). The counsel for assignee respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) And MPEP 2143. The counsel for assignee respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

First, neither Fee nor Joline, either individually or when combined, teach all of the claimed limitations. For example, neither of these references teach the limitation "overhead portion," as claimed. This limitation was previously found in independent claim 8, but has now been incorporated into the other claims. In the Office Action, the Examiner asserted "Overhead signal (subcarrier signal) is inserted at node 901, pass through node 902 and detected at node 905". Counsel for assignee respectfully disagrees. In the amended claims, "overhead portion" is used to transmit monitoring information signals so that a beginning device can insert monitoring information signals into the "overhead portion." Since the relay devices and the end-point device can then extract the monitoring information signals from the "overhead portion", these devices have some knowledge of the "overhead portion." Neither Fee nor Joline disclose such an overhead portion.

Additionally, Fee uses a subcarrier signal, which is generated by a modulation of high data rate signal, whereas the claimed invention uses "overhead portion" to transmit a monitoring information signal. In Fee only one subcarrier signal is applied to a transmission signal, whereas in the present invention plural monitoring information signals are applied to a transmission signal if there are plural "overhead portions". Therefore the subcarrier signal described in Fee and the monitoring information signal in the "overhead portion" of the claimed invention are substantially different.

Furthermore, the Examiner acknowledged that Fee does not teach monitoring a plurality of paths. However, the Examiner then asserted that it is obvious that the same method can be applied to various paths of a network and argued that Joline teaches in FIG. 2 a network with a plurality of nodes within the state of Pennsylvania and further argued that Fee teaches in col. 9 lines 38-58 to test the circuit between Scranton and Harrisburg and the circuit between King of Prussia and Harrisburg. Again counsel for assignee respectfully disagrees. It is impossible to make the test circuit between "Pittsburgh and Altoona," as asserted by the Examiner because in FIG. 2, Joline teaches that TITAN (206), which is located in Harrisburg, is at an end-point of all test circuits. Moreover, Joline does not cure the deficiencies in Fee because Joline's test control 304 is always an end-point of test circuits, whereas the claimed invention includes end-point devices that are not necessarily part of a test circuit and can be designated freely. Therefore, counsel believes that Fee and the claimed invention are substantially different.

Second, one reading Joline would not be motivated to combine it with Fee to make the claimed invention because Joline teaches that his invention is used for administering the backhauling of circuits for testing to a central location whereas the claimed invention is directed to transmitting optical signals that include a payload portion which can include signals used in services for the primary communications customers. Specifically, in column 10, lines 7-11 Joline teaches "[H]owever as applied in this invention, the network management control is used for administering the backhauling of circuits for testing to a central location instead of services for the primary communications customers." Therefore counsel for assignee does not believe that there is any motivation to combine these references.

Nevertheless, claims 1, 8, and 12 have been amended to *further* distinguish them from both Fee and Joline. First, the claims have been amended to include that monitoring parameters or monitoring information signals is determined according to an object of monitoring. Support for this amendment can be found throughout the originally filed specification and specifically on page 7, lines 19-22. Second, the claims have been amended to include an overhead portion where the monitoring parameters or monitoring information signal, which is stored or inserted, is determined. Support for this amendment can be found throughout the originally filed specification and specifically on page 11, line 33 to page 12, line 2. Third the claims have been amended to designate a beginning transmission device, a transmission device that is at the end of monitored path and a transmission device that is between said beginning and end. Support for this amendment can be found throughout the originally filed specification and specifically on page 12, lines 3-16. Finally the claims have been amended to send to the transmission devices an instruction that instructs what kind of monitoring parameters or information signal the node should deal with. The claims have also been amended to send to the transmission devices the overhead portion used for transmission of the monitoring parameters or information signal. Support for this amendment can be found throughout the originally filed specification and specifically on page 6, line 21 to page 7, line 4.

To summarize, the "subcarrier signal" and "overhead portion" are different because the "overhead portion" is determined for each monitoring information signal and each device is informed of the "overhead portion." Additionally, since Fee only mentions one monitored transmission path and Joline teaches an end-point which is a test circuit the combination of these disclosures does not teach each and every element of the claimed invention. Therefore, in light of these amendments and remarks counsel for assignee does not believe the claims are obvious and respectfully requests that the Examiner reconsider his rejection of the claims.

Appl. No. 10/038,332
Amdt. dated January 23, 2006
Reply to Office Action of July 25, 2005

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Jesus Del Castillo
Reg. No. 51,604

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300

JDC:gjs

60682389 v1